

**REMARKS****INTRODUCTION:**

In accordance with the foregoing, claims 8 and 9 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-21 are pending and under consideration. Reconsideration is respectfully requested.

**REJECTION UNDER 35 U.S.C. §112:**

In the Office Action, at page 2, numbered paragraph 2, claim 6 was rejected under 35 U.S.C. §112, second paragraph, for the reasons set forth therein. This rejection is traversed and reconsideration is requested.

Applicants respectfully submit that the language rejected is the language of claim 8, which depends from claim 6. Hence claim 8 has been amended to recite, as suggested by the Examiner: "The ink composition according to claim 6, wherein the aqueous medium is one of water alone ~~and~~or water in combination with at least one organic solvent."

Thus, claim 8 is now submitted to be in allowable form under 35 U.S.C. §112, second paragraph.

**REJECTION UNDER 35 U.S.C. §103:**

A. In the Office Action, at pages 3-4, numbered paragraph 5, claims 1, 3, 6-8, 10 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Taguchi et al. (US 2004/0011248; hereafter, Taguchi) in view of Fassler et al. (USPN 6,059,869; hereafter, Fassler). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

As an initial point of clarification, Taguchi was first published on January 22, 2004, whereas the instant application was filed in the United States on August 25, 2003. As such, it is respectfully submitted that Taguchi does not qualify as prior art under 35 U.S.C. §102(b). Additionally, the date of invention in the instant invention is at least August 28, 2002, which is the foreign priority date based upon the prior filing of the foreign counterpart to the instant application in the Korean Intellectual Property Office. A copy of the foreign counterpart was previously filed, as acknowledged by the Examiner in the Office Action Summary of the Office Action.

Further, enclosed is an English translation of Korean Application No. 2002-51157, along with a corresponding statement from the translator in compliance with 37 CFR 1.55(a)(4). As such, it is respectfully submitted that the applicants have established a date of invention of at least August 28, 2002. MPEP 210.15. Since this date of invention is prior to the publication of Taguchi on January 22, 2004, Taguchi does not qualify as prior art under 35 U.S.C. 102(a) as it was not "described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent," and thus, does not qualify as prior art under 35 U.S.C. 103(a).

Therefore, it is respectfully requested that the Examiner reconsider and withdraw the rejection of claims 1, 3, 6-8, 10 and 12 under 35 U.S.C. §103(a) in view of Taguchi.

It is respectfully submitted that Fassler does not teach or suggest utilizing polyvinyl alcohol comprising or modified with silane derivative, as is utilized in independent claims 1, 6, and 12 of the present claimed invention. It is further submitted that there is no teaching or suggestion of combining utilizing polyvinyl alcohol comprising or modified with silane derivative with Fassler, and Taguchi does not qualify as prior art with respect to the present invention.

Hence, independent claims 1, 6, and 12 of the present claimed invention are submitted to be patentable under 35 U.S.C. §103(a) over Taguchi et al. (US 2004/0011248) in view of Fassler et al. (USPN 6,059,869). Since claims 3, 7-8, and 10 depend from claims 1 and 6, claims 3, 7-8 and 10 are submitted to be patentable under 35 U.S.C. §103(a) over Taguchi et al. (US 2004/0011248) in view of Fassler et al. (USPN 6,059,869) for at least the reasons that claims 1 and 6 are patentable under 35 U.S.C. §103(a) over Taguchi et al. (US 2004/0011248) in view of Fassler et al. (USPN 6,059,869).

**B.** In the Office Action, at page 5, numbered paragraph 6, claims 9 and 15-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Taguchi et al. (US 2004/0011248; hereafter, Taguchi) in view of Fassler et al. (USPN 6,059,869; hereafter, Fassler) as applied to claims 1, 3, 6-8, 10 and 12 above, and further in view of Ma et al. (USPN 5,085,698; hereafter, Ma). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

As noted above, Taguchi was first published on January 22, 2004, whereas the instant application was filed in the United States on August 25, 2003. As such, it is respectfully submitted that Taguchi does not qualify as prior art under 35 U.S.C. §102(b). Additionally, the date of invention in the instant invention is at least August 28, 2002, which is the foreign priority date based upon the prior filing of the foreign counterpart to the instant application in the Korean Intellectual Property Office. A copy of the foreign counterpart was

previously filed, as acknowledged by the Examiner in the Office Action Summary of the Office Action.

Further, enclosed is an English translation of Korean Application No. 2002-51157, along with a corresponding statement from the translator in compliance with 37 CFR 1.55(a)(4). As such, it is respectfully submitted that the applicants have established a date of invention of at least August 28, 2002. MPEP 210.15. Since this date of invention is prior to the publication of Taguchi on January 22, 2004, Taguchi does not qualify as prior art under 35 U.S.C. 102(a) as it was not "described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent," and thus, does not qualify as prior art under 35 U.S.C. 103(a).

Therefore, it is respectfully requested that the Examiner reconsider and withdraw the rejection of claims 9 and 15-21 under 35 U.S.C. §103(a) in view of Taguchi.

As noted above, Fassler does not teach or suggest utilizing polyvinyl alcohol comprising or modified with silane derivative, as is utilized in independent claim 6 of the present claimed invention.

Ma also does not teach or suggest utilizing polyvinyl alcohol comprising or modified with silane derivative, as is utilized in independent claim 6 of the present claimed invention. In contrast, Ma teaches away from the present invention by reciting that if polyvinyl alcohol is utilized in ink applications or the like, the pigment tends to smear upon exposure to moisture (see col. 1, lines 53-61, of Ma).

Ma does not teach or suggest using an organic solvent such as ethyl acetate and ethyl lactate in combination with other solvents including alcohol, glycol, polyhydric alcohol, glycol ethers, etc., to produce ink with a desired surface tension, viscosity, and drying time, as is set forth in the present claimed invention.

It is further submitted that there is no teaching or suggestion of combining utilizing polyvinyl alcohol comprising or modified with silane derivative with Fassler and/or Ma, and Taguchi does not qualify as prior art with respect to the present invention.

Hence, independent claim 6 of the present claimed invention is submitted to be patentable under 35 U.S.C. §103(a) over Taguchi et al. (US 2004/0011248) in view of Fassler et al. (USPN 6,059,869) as applied to claims 1, 3, 6-8, 10 and 12 above, and further in view of Ma et al. (USPN 5,085,698). Since claims 9 and 15-21 depend, directly or indirectly, from claim 6, claims 9 and 15-21 are submitted to be patentable under 35 U.S.C. §103(a) over Taguchi et al. (US 2004/0011248) in view of Fassler et al. (USPN 6,059,869) as applied to claims 1, 3, 6-8, 10

and 12 above, and further in view of Ma et al. (USPN 5,085,698) for at least the reasons that claim 6 is patentable under 35 U.S.C. §103(a) over Taguchi et al. (US 2004/0011248) in view of Fassler et al. (USPN 6,059,869) as applied to claims 1, 3, 6-8, 10 and 12 above, and further in view of Ma et al. (USPN 5,085,698).

C. In the Office Action, at pages 5-7, numbered paragraph 7, claims 1-8 and 10-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Taguchi et al. (US 2004/0011248; hereafter, Taguchi) in view of Morehouse (USPN 2,928,858; hereafter, Morehouse). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

A noted above, Taguchi was first published on January 22, 2004, whereas the instant application was filed in the United States on August 25, 2003. As such, it is respectfully submitted that Taguchi does not qualify as prior art under 35 U.S.C. §102(b). Additionally, the date of invention in the instant invention is at least August 28, 2002, which is the foreign priority date based upon the prior filing of the foreign counterpart to the instant application in the Korean Intellectual Property Office. A copy of the foreign counterpart was previously filed, as acknowledged by the Examiner in the Office Action Summary of the Office Action.

Further, enclosed is an English translation of Korean Application No. 2002-51157, along with a corresponding statement from the translator in compliance with 37 CFR 1.55(a)(4). As such, it is respectfully submitted that the applicants have established a date of invention of at least August 28, 2002. MPEP 210.15. Since this date of invention is prior to the publication of Taguchi on January 22, 2004, Taguchi does not qualify as prior art under 35 U.S.C. 102(a) as it was not "described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent," and thus, does not qualify as prior art under 35 U.S.C. 103(a).

Therefore, it is respectfully requested that the Examiner reconsider and withdraw the rejection of claims 1-8 and 10-14 under 35 U.S.C. §103(a) in view of Taguchi.

Morehouse does not teach or suggest utilizing polyvinyl alcohol comprising or modified with silane derivative, as is utilized in independent claims 1, 6, 11 and 12 of the present claimed invention.

It is further submitted that there is no teaching or suggestion of combining utilizing polyvinyl alcohol comprising or modified with silane derivative with Morehouse, and Taguchi does not qualify as prior art with respect to the present invention.

Hence, independent claims 1, 6, 11, 12, 13 and 14 of the present claimed invention are submitted to be patentable under 35 U.S.C. §103(a) over Taguchi et al. (US 2004/0011248) in view of Morehouse (USPN 2,928,858). Since claims 2-5, 7-8, and 10 depend from claims 1 and 6, respectively, claims 2-5, 7-8, and 10 are submitted to be patentable under 35 U.S.C. §103(a) over Taguchi et al. (US 2004/0011248) in view of Morehouse (USPN 2,928,858) for at least the reasons that claims 1 and 6 are patentable under 35 U.S.C. §103(a) over Taguchi et al. (US 2004/0011248) in view of Morehouse (USPN 2,928,858).

D. In the Office Action, at pages 7-8, numbered paragraph 8, claims 9 and 15-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Taguchi et al. (US 2004/0011248; hereafter, Taguchi) in view of Morehouse (USPN 2,928,858; hereafter, Morehouse) as applied to claims 1-8 and 10-14 above, and further in view of Ma et al. (USPN 5,085,698; hereafter, Ma). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Claim 9 has been amended for clarity. Applicants thank the Examiner for pointing out that clarification might be needed.

As noted above, Taguchi was first published on January 22, 2004, whereas the instant application was filed in the United States on August 25, 2003. As such, it is respectfully submitted that Taguchi does not qualify as prior art under 35 U.S.C. §102(b). Additionally, the date of invention in the instant invention is at least August 28, 2002, which is the foreign priority date based upon the prior filing of the foreign counterpart to the instant application in the Korean Intellectual Property Office. A copy of the foreign counterpart was previously filed, as acknowledged by the Examiner in the Office Action Summary of the Office Action.

Further, enclosed is an English translation of Korean Application No. 2002-51157, along with a corresponding statement from the translator in compliance with 37 CFR 1.55(a)(4). As such, it is respectfully submitted that the applicants have established a date of invention of at least August 28, 2002. MPEP 210.15. Since this date of invention is prior to the publication of Taguchi on January 22, 2004, Taguchi does not qualify as prior art under 35 U.S.C. 102(a) as it was not "described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent," and thus, does not qualify as prior art under 35 U.S.C. 103(a).

Therefore, it is respectfully requested that the Examiner reconsider and withdraw the rejection of claims 9 and 15-21 under 35 U.S.C. §103(a) in view of Taguchi.

As noted above, Morehouse does not teach or suggest utilizing polyvinyl alcohol comprising or modified with silane derivative, as is utilized in independent claim 6 of the present claimed invention.

It is further submitted that there is no teaching or suggestion of combining utilizing polyvinyl alcohol comprising or modified with silane derivative with Morehouse and/or Ma, and Taguchi does not qualify as prior art with respect to the present invention. In addition, Ma teaches away from the present invention by reciting that if polyvinyl alcohol is utilized in ink applications or the like, the pigment tends to smear upon exposure to moisture (see col. 1, lines 53-61, of Ma).

Also, there is no teaching or suggestion of combining utilizing polyvinyl alcohol comprising or modified with silane derivative with Morehouse and/or Ma, and Taguchi does not qualify as prior art with respect to the present invention.

Hence, independent claim 6 of the present claimed invention is submitted to be patentable under 35 U.S.C. §103(a) as being unpatentable over Taguchi et al. (US 2004/0011248) in view of Morehouse (USPN 2,928,858) as applied to claims 1-8 and 10-14 above, and further in view of Ma et al. (USPN 5,085,698). Since claims 9 and 15-21 depend, directly or indirectly, from claim 6, claims 9 and 15-21 are submitted to be patentable under 35 U.S.C. §103(a) as being unpatentable over Taguchi et al. (US 2004/0011248) in view of Morehouse (USPN 2,928,858) as applied to claims 1-8 and 10-14 above, and further in view of Ma et al. (USPN 5,085,698) for at least the reasons that claim 6 is patentable under 35 U.S.C. §103(a) as being unpatentable over Taguchi et al. (US 2004/0011248) in view of Morehouse (USPN 2,928,858) as applied to claims 1-8 and 10-14 above, and further in view of Ma et al. (USPN 5,085,698).

#### **CONCLUSION:**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

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If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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